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TRANSMITTAL FORM

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Application Number	10/614,584
Filing Date	07/07/2003
First Named Inventor	Frank Gordon Krausz
Art Unit	2178
Examiner Name	Huynh, Cong Lac
Attorney Docket Number	10547.26US2

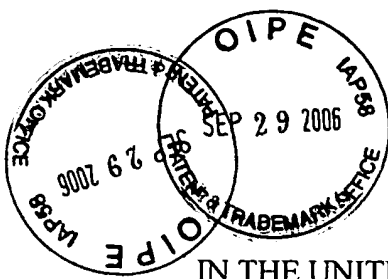Total Number of Pages in This Submission   15

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Customer No. 34018 Greenberg Traurig, LLP
Signature	
Printed name	Gary R. Jarosik
Date	September 26, 2006	Reg. No.	35,906

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Krausz	)	Examiner:	Huynh, Cong Lac
		)		
Application No.:	10/614,584	)	Attny Doc.:	10547.26US2
		)		
Filing Date:	July 7, 2003	)	Art Unit:	2178
		)		
Title:	System And Method For	)		
	Generating Invoices Using	)		
	A Markup Language	)		

APPEAL BRIEF

Mail Stop Appeal Briefs - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the

Examiner's final rejection of claims 14-22 which rejection was set forth in the Office Action

mailed July 21, 2006. A timely Notice of Appeal was filed.

This brief is accompanied by the fee required by 37 CFR § 41.20

This Appeal Brief is being filed in triplicate.

The Commissioner is hereby authorized to charge any fee deficiency or credit

overpayment to deposit account number 50-2428 in the name of Greenberg Traurig.

10/02/2006 DEHHANU1 00000004 10614584
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I.   Real Party In Interest

The real party in interest is CSG Systems, Inc.

II.   Related Appeals And Interferences

There are no known related appeals or interferences.

III. Status Of The Claims

In the application, claims 14-22 remain pending and, having been finally rejected, are the subject of this appeal. Claims 1-13 were canceled during the course of prosecution.

The Section VIII appendix provides a clean, double spaced copy of pending claims 14-22.

IV.   Status Of Amendments

The claims are in condition for appeal – no amendments to the claims are pending.

V.   Summary Of The Claimed Subject Matter

The subject matter defined in independent claim 14 is generally directed to a method for generating an invoice.

The subject matter defined in independent claim 20 is generally directed to a system for generating an invoice.

With reference to Figs. 1 and 2 and paragraphs 0021+ of corresponding U.S. Published Application No. 2004/006789, the method of independent claim 14 and the system of independent claim 20 function to generate an invoice by using an invoice markup language ("IML") file created through the use of a graphical user interface tool. The IML file created through use of the graphical user interface tool includes a first set of IML tags defined by a

document type definition that are used to select data from a database (68) for inclusion in the invoice and a second set of IML tags defined by the document type definition that are used to specify both a page style for the invoice and how the data selected from the database (68) is to be displayed within the invoice. Once the IML file is created through use of the graphical user interface tool, the IML file is provided to an invoice generating application. The invoice generating application functions to access the database (68) to collect the data according to the first set of tags of the IML file and functions to use the collected data and the second set of tags of the IML file to generate an invoice output file. The generated invoice output file is then provided to an output device, such as a printer (70), a client device (64 or 66), etc., and the output device uses the invoice output file to generate the invoice.

VI.   Grounds Of Rejection To Be Reviewed On Appeal

1.   Whether the rejection under 35 U.S.C. § 103 of claims 14-22 based primarily upon the combination of Viswanath (U.S. Published Application No. 2003/0074271), Matsakis (U.S. Published Application No. 2005/0273772), and Peat ("Introducing XML/EDI...'the business framework'") can be maintained when the burdens associated with presenting a *prima facie* case of obviousness with respect to the claims have not been met.

VII. Argument

A) Summary of the rejection of the claims

In rejecting the claims it was asserted that Viswanath discloses using a graphical user interface to create a file for generating a purchase order which includes tags (in paras. 0049-0058) with the tags including tags for selecting data for inclusion in the purchase order (in paras.

0016, 0017, and 0019) and tags for specifying a layout for the purchase order including selected data (in paras. 0018, 0021, and 0084-0086). It was additionally asserted that Viswanath discloses accessing a database to collect data according to the tags and using the collected data to generate a purchase output file (in paras. 0016-0021) with the purchase output file being provided to an output device which uses the purchase output file to generate the purchase order (in paras. 0018 and 0021).

It was acknowledged that Viswanath fails to disclose, teach, or suggest generating an invoice as claimed. It was, however, asserted that Matsakis discloses using XML format for business documents such as invoices and purchases orders (in paras. 0012). It was therefore concluded that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Matsakis into Viswanath for generating an invoice *"using the same method as in Viswanath"* since invoices or purchase orders are business documents including specific data related to invoices and purchase orders.

It was further acknowledged that Viswanath and Matsakis fail to disclose, teach, or suggest an invoice markup language ("IML") as claimed. It was, however, asserted that Peat notes that one can define their own markup language with XML. It was therefore concluded that it would have been obvious to have combined Peat into Viswanath and Matsakis since, among other reasons, it is possible according to Peat to define a particular markup language for generating an invoice.

B) Applicable Law

It is well settled that a determination of obviousness requires that a combination of prior art references include each and every element set forth in the claims, considering each and every word. Furthermore, when determining the patentability of a claimed invention, it is

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impermissible to distill an invention down to the "gist" or "thrust" as this disregards the

requirement of analyzing the subject matter "as a whole." W.L. Gore & Associates, Inc. v.

Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

C) The Burdens Associated With Presenting A *Prima Facie* Case Of Obviousness With Respect
   To The Claims Has Not Been Met

It is respectfully submitted that the rejection of the claims fails to meet the burdens

associated with presenting a *prima facie* case of obviousness for the reason that Viswanath,

Matsakis, and Peat, whether considered alone or in combination, fail to disclose, teach, or

suggest all of the elements set forth in the claims.

More particularly, it is respectfully submitted that each of Viswanath, Matsakis, and Peat

fails to disclose, teach, or suggest at least the expressly claimed element of providing a graphical

user interface tool to create a file (whether IML or otherwise) that includes a first set of tags

(whether IML of otherwise) defined by a document type definition that are used *to select data* for

inclusion in a document (whether an invoice or otherwise) *and* a second set of tags (whether IML

or otherwise) defined by the document type definition that are used to specify *both a page style*

for the document and how to display the selected data within the document.

While the rejection of the claims has asserted that Viswanath discloses a graphical user

interface tool for creating a file including XML tags for selecting data for inclusion in a purchase

order and for specifying a layout for the purchase order including the selected data, it is

respectfully submitted that Viswanath does not disclose using a graphical user interface tool for

this purpose. Instead, Viswanath only discloses the use of a graphical user interface tool for the

purpose of allowing an existing electronic catalog to be mapped to the e-procurement system

disclosed within Viswanath:

Catalog management module 200 allows suppliers to map their

> existing catalogs to the e-procurement system 120 using a set of
> graphical user interface tools.

(Viswanath; para. 0051).

Viswanath does not disclose, teach, or suggest using the graphical user interface tool for any

other purpose. More importantly, Viswanath never discloses, teaches, or suggests using the

graphical user interface tool to create a file that includes both a first set of tags defined by a

document type definition that are used *to select data* for inclusion in a document, particularly a

purchase order as alleged in the rejection of the claims, *and* a second set of tags defined by the

document type definition that are used to specify *both a page style for the document and how to*

display the selected data within the document.

That Visnawath fails to disclose, teach, or suggest this expressly claimed element is

further evidenced in the Advisory Action of August 14, 2006 wherein it has been asserted in

support of the rejection that "any business transaction system uses a graphical user interface to

perform business functions." While this statement may or may not be true, it is respectfully

noted that this naked assertion still fails to evidence that Viswanath, or any other reference of

record, discloses, teaches, or suggests the desirability of using a graphical user interface tool for

the express purpose claimed as is required of a *prima facie* case of obviousness, i.e., to create an

IML file having both types of claimed tags.

It is additionally respectfully submitted that it is evidenced that all of the elements of the

claims have not been considered by the Examiner when determining the patentability of the

claims at issue with the Examiner instead impermissibly distilling the claimed invention down to

its "gist" or "thrust." For example, the Examiner has asserted that the Appellant is arguing that

"the cited references do not disclose using the graphical user interface for creating an invoice."

(*see* Office Action of July 21, 2006, page 7). This is not, however, what is being argued by the

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Appellant. What is being argued by the Appellant is that no cited reference discloses, teaches, or suggests the claimed graphical user interface tool that is used to create a file that includes both a first set of tags defined by a document type definition that are used *to select data* for inclusion in a document *and* a second set of tags defined by the document type definition that are used to specify *both a page style for the document and how to display the selected data within the document.*

Rather than disclose, teach, or suggest these expressly recited claimed elements, Viswanath discloses a system which generates OBI XML formatted purchase orders for sending to suppliers which includes a XML translation of an entire in-bound XML formatted requisition request received from a buyer which translation is performed using a "two-step XML file translation process." Specifically, in Viswanath it is not a file created using a graphical user interface tool that defines *both* the style and the data that is to be selected for inclusion in the to-be-created purchase order. Instead, Viswanath discloses, in direct contrast to that which is claimed, that it is *the requisition request received at a "translation engine" that is used to select the data that is to be included in the to-be-created purchase order.* (Paras. 0014, 0018, 0019, 0023, 0024, 0054-0056, 0073, and 0084 for example). Thus, it is evident that nothing from Viswanath discloses, teaches, or suggests the claimed graphical user interface tool which allows for the creation of a file where the file created using the graphical user interface tool includes *all* of the elements set forth within the claims.

While the requisition request received at the "translation engine" of the Viswanath system performs the function of selecting the data that is to be included in the to-be-created purchase order, it is further evidenced within Viswanath that the received requisition request, which alone functions to select the data for inclusion in the to-be-created purchase order, is not

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the same file that also functions to specify the layout for the to-be-created purchase order. In this regard, Viswanath expressly describes that any formatting associated with the received requisition request is itself completely disregarded when the purchase order is created by the e-procurement system of Viswanath:

> Contents of the purchase requisition are then mapped into an internal proprietary XML data format to allow for the quick and effective processing of the purchase requests. The mapped XML data is then **reformatted** and delivered in an XML format suitable for delivery in response to the purchase request. In one embodiment of the present invention, an Extensible Markup Language (XML) may be used to format content requests from the user to the purchasing and procurement system. The purchasing and procurement system then may use a sub-processing XDOC framework to generate XML data **fetched** and parsed **in response to the user's request.**

(Viswanath; para. 0018; emphasis added).

Instead of disclosing, teaching, or suggesting using a file having a document definition including tags for performing the specific tasks claimed, Viswanath suggests using a translation process where the data selected, i.e., fetched, from an external XML catalog source as a function of the information within the requisition request is merely "formatted to transform the XML content from an external source into an appropriate markup content for delivery..." (Para. 0014). Thus, from the foregoing, it is evident that no single file disclosed within Viswanath, whether created using a graphical user interface tool or otherwise, includes a document definition having tags which function to **both** _select data_ for inclusion in a document and to specify _a page style for the document and how to display the selected data within the document._

Considering now Matsakis, it is respectfully submitted that Matsakis similarly fails to disclose, teach, or suggest at least the claim elements discussed above that are missing from Viswanath. In this regard, Matsakis, like Viswanath, discloses nothing more than a system that functions to perform conversions between different XML formats to achieve server-to-server

transfer of invoices, purchase orders and other business data streamed in the e-business context. Thus, while Matsakis generally mentions using XML in connection with invoices, in Matsakis, as in Viswanath, there is no disclosure, teaching, or suggestion of a file created using a graphical user interface tool that has a document definition which includes tags, let alone IML tags, that defines *both* the style and the data to select for inclusion in a document, let alone an invoice. Accordingly, it is respectfully submitted that nothing from Matksakis can be said to suggest modifying Viswanath to arrive at the exact invention claimed.

Finally, while Peat may disclose that one might define their own markup language with XML, like both Viswanath and Matksakis, nothing from Peat discloses, teaches, or suggest the claimed graphical user interface tool which allows for the creation of an IML file used to generate a formatted invoice that includes *all* of the elements set forth within the claims. Accordingly, it is respectfully submitted that nothing from Peat can be said to suggest modifying either Viswanath or Matksakis to arrive at the exact invention claimed.

From the foregoing, it is respectfully submitted that the combination of Viswanath, Matksakis, and Peat cannot be said to disclose the entirety of the invention now claimed as is required of a *prima facie* case of obviousness. Furthermore, it is respectfully submitted that, were one of skill in the art to generate an invoice "*using the same method as in Viswanath*" as asserted in the Office Action of July 21, 2006, one would be lead to a system in which a first file is utilized to do <u>nothing</u> more than select data from an external source for inclusion within an invoice and <u>a separate</u> translation process, which <u>disregards</u> any formatting specified by the first file, is then utilized to merely "transform the XML content from an external source into an appropriate markup content for delivery..." It is respectfully noted that this method for generating an invoice is in direct contrast to that which is set forth in the claims.

For at least these reasons it is respectfully submitted that the rejection of the claims under
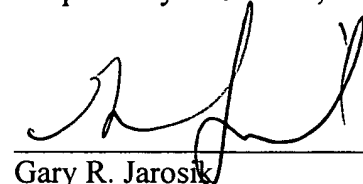
35 U.S.C. § 103 must be withdrawn.

D) Conclusion

It is respectfully submitted that the application is in good and proper form for allowance.

Such action of the part of the Board is respectfully requested.

Respectfully Submitted;

Date: September 26, 2006   By: _____
                                            Gary R. Jarosik
                                            Reg. No. 35,906
                                            Greenberg Traurig, LLP
                                            77 W. Wacker Drive, Suite 2500
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                                            (312) 456-8449

VIII. Claims Appendix

The following is a clean copy of the claims involved in the appeal:

1-13. (Canceled)

14. A method for generating an invoice, comprising:

using a graphical user interface tool to create an IML file including a first set of IML tags defined by a document type definition that are used to select data for inclusion in the invoice and a second set of IML tags defined by the document type definition that are used to specify both a page style for the invoice and how the selected data is to be displayed within the invoice;

providing the IML file to an invoice generating application which accesses a database of a service provider to collect data according to the first set of tags and which uses the collected data and the second set of tags to generate an invoice output file; and

providing the invoice output file to an output device which uses the invoice output file to generate the invoice.

15. The method as recited in claim 14, wherein the invoice output file comprises an HTML file.

16. The method as recited in claim 15, further comprising transmitting the output file via a network to the output device.

17. The method as recited in claim 16, wherein the output device comprises a hand-held processing device.

18. The method as recited in claim 16, wherein the output device comprises a personal computer.

19. The method as recited in claim 14, wherein the invoice output file comprises a printer-control language file.

20. A system for generating an invoice, comprising:

a database having stored thereon data associated with a customer service organization;

a graphical user interface tool for creating an IML file including a first set of IML tags defined by a document type definition that are used to select data for inclusion in the invoice and a second set of IML tags defined by the document type definition that are used to specify both a page style for the invoice and how the selected data is to be displayed within the invoice; and

an invoice generating application which accesses the database to collect data according to the first set of tags and which uses the collected data and the second set of tags to generate an invoice output file.

21. The system as recited in claim 20, wherein the invoice output file comprises an HTML file.

22. The system as recited in claim 20, wherein the invoice output file comprises a printer-control language file.

IX. Evidence Appendix

No evidence is being submitted herewith.

X. Related Proceedings Appendix

No copies of decisions rendered by a court or the Board are being submitted herewith.

CHI 56548440v1